



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

MAR 19 2003

B. J. SADOFF
NIXON & VANDERHYE P.C.
1100 NORTH GLEBE ROAD, 8TH FLOOR
ARLINGTON, VA 22201-4714

41

In re Application of :
Geert Maertens et al :
Serial No.: 08/836,075 : PETITION DECISION
Filed: April 21, 1997 :
Attorney Docket No.: 2752-31 :

This is a decision on the petition under 37 CFR 1.181, filed December 19, 2002, requesting removal of an improper restriction requirement.

BACKGROUND

A review of the pertinent portion of the file history shows that this application was allowed and the Issue Fee was paid prior to September, 1999. Through error the application was held abandoned in August, 2000, and the abandonment rescinded in December, 2000. In January, 2001, a petition under 37 CFR 1.313 accompanied by an RCE request and an IDS statement was filed. The petition was granted on January 26, 2001, which was too late to prevent publication of the patent, per se. By Notice in the Official Gazette indication was given that no patent had issued for the assigned number. The application was then returned to the examiner for further action.

Subsequently several additional IDS statements were submitted as well as an amendment. The examiner mailed an Office action to applicants on November 19, 2002, setting forth a two way restriction requirement, as follows:

Group I, claims 75-84, drawn to unique polypeptides from differing HCV genomes;
Group II, claim 85, drawn to a purified polypeptide.

In addition, the election of a single amino acid sequence was required irrespective of whichever group was elected. Applicants replied on December 19, 2002, electing Group I and SEQ ID NO. 43 with traverse. Applicants also filed this petition to have the restriction requirement withdrawn.

DISCUSSION

Applicants argue that all of the claims currently active in the application were prosecuted and allowed by the same examiner in June, 1999. Applicants have amended the claims only to cancel one dependent claim and to remove some of the sequence identifiers from the claims so as to avoid newly submitted prior art. Applicants argue that since all of the claims were previously considered together they should not be divided now. Applicants basically argue that the Office has been inconsistent in prosecution of this application and that the restriction requirement should be withdrawn.

It is also noted that this application is the National Phase filing of PCT/EP95/04155. As such the making of a restriction requirement solely under 35 U.S.C. 121 without consideration of PCT Rule 13 provisions is improper. As only RCE papers have been filed this application remains a National Phase application.

DECISION

Applicants' petition is **GRANTED**.

The restriction requirement of the last Office action is withdrawn. The application will be forwarded to the examiner for consideration of the response filed December 19, 2002.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll 
Director, Technology Center 1600